

REMARKS

This patent application presently includes claims 1-18, all of which stand rejected. The claims are amended to define the applicant's invention more clearly and all rejections are respectfully traversed.

All claims stand rejected as obvious over Warmus, U.S. Patent No. 6,327,599 in view of Barnes, "10 Minute Guide To Windows 3.1." In the case of claims 4 and 12, Ikenoue et al., U.S. Patent No. 4,987,127, is, in addition, added to the combination.

It would appear that the Examiner cannot distinguish between a system in which a document is modified on the verge of printing, as it exits the spooler, from a system in which complex template files are created and used to create a multiplicity of alternate pages, after which alternate versions of documents are assembled and printed separately. The former is a capsule description of the present invention, whereas the latter describes Warmus, the primary reference in the current instance. This distinction has been the subject of contention for over three years of prosecution and different generations of this application.

In order to focus the issue, the undersigned has now amended the claims to highlight the role of the print spool, its interaction with the printer, and to have the invention generate a new document at the moment when the original one is about to print. This has been done by amplifying the preamble to add life and meaning to the claim limitations and amending the elements of the claim to provide more interaction and cooperation with the print spool. In particular, it should be noted that the "tool" claims now include a connection to the output of the print spool and certain limitations indicate how the print spool is monitored and/or its output accessed. This places the focus on what the issues have been all along and, hopefully, will avoid excessively liberal interpretation and reading into the prior art by the examiner.

In summary, the examiner has taken the position that Warmus teaches that data is intercepted when it is sent to the printer, while he admits that Warmus does not disclose a print spool associated with the printer. However, he cites Barnes for its disclosure that a print spooler may be used and, with a wave of the hand, concludes that the present invention would be obvious by combination Barnes with Warmus.

First of all, it needs to be noted that Warmus is fundamentally different from the present invention. For example, referring to FIG. 5, it will be clear that Warmus, in fact, contemplates a complex document assembly system. It could hardly be concluded that a document is changed on

the way to the printer as it is about to be printed. Indeed, it is clear from FIG. 5 that a complex set of operations must be followed and different versions of documents assembled before the document is even released to the print system. The obvious reason why no print spool is disclosed is that this is a fundamentally different system in which the use of a print spool would be ludicrous. The system is appropriate in a large factory where books are assembled and printed, but it could hardly be used with a personal computer driving a printer, as the present invention.

Which brings us to the next point. The fact that print spoolers existed at the time that the present invention was made does not change the situation at all. Clearly, they must have existed if the present invention uses them. However, to cite a complex manufacturing system and conclude that the present invention is obvious because print spoolers existed is, indeed, a giant step. The examiner has made absolutely no effort to demonstrate how such a combination would be made or how it could result in the present invention. In the last response, the applicant considered such a combination in every location in which a spooler could be placed in the Warmus system to arrive at the present invention. The unavoidable conclusion was that it could not happen. As has been the case throughout the prosecution, the latest Office Action is essentially a copy of the one issued years ago. The only difference is in the "Response To Arguments." However, the examiner made absolutely no response to the demonstration that combining a spooler with Warmus could not result in the present invention. It would appear that he has not even considered that argument.

The fact that two references exist does not mean that they would be combined by those skilled in art. For a proper obviousness rejection over a combination of references, there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself. *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992). That is what is entirely absent from the record of the present patent application. Indeed the examiner's only rationale for even attempting the combination is the disclosure of the present patent application.

It is therefore requested that the present amendment be entered and that all of the claims be allowed as presently constituted. Moreover, if the examiner persists in this rejection, it is assumed that he will have a substantially better basis than he does right now. In particular, as the record stands, the only conclusion that could be reached is that the examiner is making this rejection on the basis of his personal knowledge. Accordingly, the applicant calls upon the examiner to make his rejection more specific and support the same with an affidavit as required by 37 C.F.R.

1.104(d)(2), which shall be subject to contradiction or explanation by the affidavits of appropriate experts.

It is realized that, after final rejection, entry of amendments is in the discretion of the examiner, assuming they place the application in better condition for allowance or appeal. There can be no question that the present amendment places the application in better condition for allowance or appeal. Furthermore, in view of the record in the present application, it would be disingenuous for the examiner to refuse entry of the amendment on the ground that it raises new issues or would require further searching. Presumably, with this issue being argued so long, the examiner has apparently considered it thoroughly and made all the searches that would be necessary. Thus, if the examiner truly believes that his position is correct, he will enter the current amendment and let the Board of Appeals decide the issue.

A Notice of Appeal has been filed.

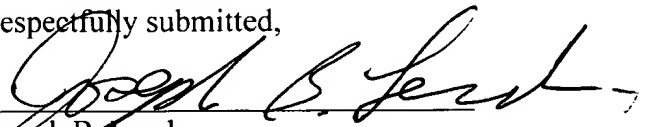
Applicant's has made every effort to place this patent application in condition for allowance and has demonstrated that allowance would be appropriate in the present instance. It is therefore earnestly requested that the present amendment be entered and that all of the claims be allowed as presently constituted. Should there remain any unanswered questions, the examiner is requested to call the applicant's undersigned attorney at the telephone number indicated below.

The Commissioner is authorized to charge our Deposit Account No. 11-0223 for any fees due with this response.

Dated: September 21, 2006

Respectfully submitted,

By:


Joseph B. Lerch

Registration No.: 29,936

KAPLAN GILMAN GIBSON & DERNIER LLP

900 Route 9 North, Suite 504

Woodbridge, New Jersey 07095

(732) 634-7634

Attorneys for Applicant